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H01

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/305,586 05/05/99 HAGE

M 589.015US1

EXAMINER

IM52/0814

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JOHNSTONE, A

ART UNIT

PAPER NUMBER

1733

DATE MAILED:

08/14/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/305,586

Applicant(s)
Hage

Examiner
Adrienne Johnstone

Art Unit
1733



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three (3) MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 Jan 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 21-24 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 21-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 8 20) ☐ Other:

Art Unit: 1733

DETAILED ACTION

Information Disclosure Statement

1. In the Information Disclosure Statement filed August 21, 2000 applicant states that the references cited therein were also cited in a communication from a foreign patent office in a counterpart application, however applicant did not submit a copy of the communication (which is typically a search report indicating the degree of relevance of each reference). The examiner hereby requests a copy of this communication.

This request is repeated from Paper Number 7 paragraph 5: applicant did not address this request in the amendment filed January 25, 2001.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-16 and 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spector et al. (5,883,169) cited by applicant in view of Fischer et al. (5,130,353), Marias Albrich et al. (6,033,718), and Beavers et al. (6,106,889).

The only difference between the Spector et al. method and the claimed method is that the temporary protective film is removed by peeling rather than dissolving or dispersing with a solvent

Art Unit: 1733

that does not attack the polymeric optical element (Spector et al. entire document), however a conventional alternative technique for removing temporary films from polymeric ophthalmic lenses is removal by dissolving or dispersing the film with such a solvent, such as water or an aqueous solution, as evidenced by Fischer et al. (col. 2 lines 46-52 and col. 7 lines 30-46), Marias Albrich et al. (col. 1 line 5 - col. 2 line 19), and Beavers et al. (col. 2 line 26 - col. 3 line 52). It would have been obvious to one of ordinary skill in the art to employ such a conventional alternative technique for removal of the temporary protective film in the Spector et al. '169 method. As to claims 9-14, it would have been obvious to one of ordinary skill in the art to select for the film in the above method any conventional polymer material capable of dissolving or dispersing in the water or aqueous solution (such as the blend of polyvinyl resin and cellulose-based polymer disclosed in Fischer et al., col. 2 lines 39-45, or the polyvinyl resin, cellulose-based polymer, or acrylic polymer disclosed in Beavers et al.).

Applicant challenged the examiner's position that a conventional alternative technique for removing temporary films from polymeric ophthalmic lenses is removal by dissolving or dispersing the film with such a solvent, such as water or an aqueous solution, so the examiner has provided evidence (the three additional references) supporting this position.

Conclusion

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 1733

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adrienne Johnstone whose telephone number is (703) 308-2059. The examiner can normally be reached on Monday through Friday from 11:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Ball, can be reached on (703) 308-2058. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310 for official after final faxes and (703) 872-9311 for all other official faxes.

Art Unit: 1733

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Adrienne Johnstone

August 9, 2001



Adrienne Johnstone

Primary Examiner

Art Unit 1733